

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NORMAN E. CHASEK

Appeal No. 96-3053
Application 08/113,194¹

ON BRIEF

Before KRASS, JERRY SMITH and CARMICHAEL, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed August 30, 1993.

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This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 9-14, which constitute all the claims remaining in the application. We note that appellant's initial appeal brief indicated that claims 10 and 12 were to be cancelled and that the appeal was made with respect to claims 9, 11, 13 and 14 [brief, page 1]. Notwithstanding this indication, the appeal brief also presented arguments as to why claims 10 and 12 were patentable. Because of these arguments, the examiner did not cancel claims 10 and 12 and considered the arguments against all the claims present in the application. Therefore, we treat this appeal as being directed to the rejection of all of claims 9-14.

The claimed invention pertains to a method and apparatus for automatically settling payments between different autonomous toll authorities. More particularly, tolls which have been paid to one toll authority by a vehicle owner are automatically transferred to a second toll authority when the vehicle uses the toll facilities run by the second authority.

Representative claim 9 is reproduced as follows:

9. A method for automating inter Authority settlements between a plurality of autonomous Authorities employing debited electronic toll paying, without a central intervening third party, is comprised of the steps of:

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reading out by a Toll Collecting Terminal, or TCT, from each passing In-Vehicle-Terminal, or IVT, a Personal Identification Number, or PIN, and a Prepaid Authority Identification Number, or PPA-IDN;

combining said IVT supplied numbers with the collecting Authority's Identification Number and toll amount supplied by the TCT to form a toll transaction;

assigning to each toll transaction an m/n address which designates the Authority to whom funds have been prepaid by m, and the Authority to whom the toll is being paid by n, said m/n address helps direct data to its m/n designated storage bin and forms a toll transaction message, or TTM, which at a minimum consists of the m/n address, PIN, and toll amount;

reading out like-m/n batched TTMs from each said data storage bin during preassigned time slots;

directing the resulting TTM batches to a communications interface where TTM batches are transmitted to the designated Authorities during said assigned time slots;

receiving TTM batches from other Authorities and feeding said TTM batches into a second, synchronized assigned-time switch which directs the appropriate m addressed batch from each Authority onto the n assigned busline, based on its time of arrival;

extracting toll amounts from each TTM and processing them into running sums for each busline, with each busline's running sum being periodically fed into a busline-assigned electronic check writer, ECW, which addresses that busline's running sum so it will credit and debit that busline's assigned bank accounts, then reset said running sum to zero; and

using the banking system's Electronic Funds Transfer System, EFTS, to complete the inter-bank fund transfers as directed by said ECW.

The examiner relies on the following references:

Arnold et al. (Arnold)	4,558,176	Dec. 10, 1985
Marker, Jr.	4,802,220	Jan. 31, 1989
Hassett et al. (Hassett)	5,086,389	Feb. 04, 1992

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Claims 9-14 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Hassett taken alone with respect to claims 9, 10, 12 and 13, and adds Marker, Jr. or Arnold with respect to claims 11 and 14.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answers for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answers.

It is our view, after consideration of the record before us, that the collective evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 9-14. Accordingly, we reverse.

We consider first the rejection of claims 9, 10, 12 and 13 under 35 U.S.C. § 103 as unpatentable over Hassett. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re

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Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

As indicated by the cases just cited, the examiner has at least two responsibilities in setting forth a rejection under 35 U.S.C. § 103. First, the examiner must identify all the differences between the claimed invention and the teachings of the prior art. Second, the examiner must explain why the identified differences would have resulted from an obvious modification of the prior art. In our view, the examiner has not properly addressed the first responsibility so that it is impossible that the second responsibility has been successfully fulfilled.

With respect to claim 9, we find that the examiner has not properly addressed the differences between the invention as recited in the claim and the teachings of Hassett. One particular aspect of the invention as recited in claim 9 is that there must be an automatic transfer of funds between different toll collection authorities. Although the examiner alleges that Hassett performs this function, we fail to find this teaching in Hassett.

The Hassett toll collection system merely suggests that a given in-vehicle component (IVC) may be operative with a

plurality of different toll authorities. Each toll authority would cause the IVC to debit an account associated with that toll authority. This does not suggest that any communication takes place between toll authorities. On the contrary, each toll authority in Hassett is paid in advance by cash or credit card to place an amount of money into an account for each toll authority. If the IVC does not have enough money to pay a toll to a specific toll authority, the operator is alerted to pay by hand. There is no reason or suggestion why financial information would ever have to be exchanged between different toll authorities in Hassett. The only communication in Hassett occurs between the IVC and each toll authority but does not occur between toll authorities. Thus, the examiner's basic premise that Hassett suggests the maintenance of toll accounts among a plurality of toll authorities is not supported by the teachings of Hassett.

Even assuming arguendo that Hassett could be said to suggest the transfer of money between toll collection authorities, the examiner has still failed to address the specific steps recited in claim 9. Instead of considering the specific recitations of claim 9, the examiner simply concludes that "[t]he various limitations in claim 9 directed to addressing inter-toll transactions, collecting and batching various toll

transaction information, and extracting or processing the appropriate toll amounts accordingly, are simply steps that fall within the penumbra of activities performed either manually or in a semi-automated fashion within existing systems of toll collection and settlement" [answer, page 5]. We fail to see how the steps of assigning an m/n address to form a message, batching such m/n messages during preassigned time slots and synchronizing assigned time slots to corresponding buslines fall within the "penumbra" of activities performed by existing systems. This is a mere conclusion of the examiner unsupported by the evidence of record.

Since Hassett does not support the rejection of claim 9 as formulated by the examiner, we do not sustain the rejection of claim 9. Claims 10 and 12 depend from claim 9 so that the rejection of these claims is also not supported by Hassett. Claim 13 has been treated by the examiner and appellant as essentially equivalent to claims 9, 10 and 12. Therefore, the rejection of claim 13 is not sustained for the same reasons discussed above.

We now consider the rejection of claims 11 and 14 as unpatentable over Hassett in view of Marker, Jr. or Arnold.

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Although there are substantial differences between the recitations of claims 11 and 14 and the other claims, the examiner has relied on Hassett as "applied to claims 9 and 13" in view of Marker, Jr. or Arnold [answer, pages 7-8]. As we noted above, Hassett does not support the rejection of claims 9 and 13. Since the teachings of Marker, Jr. and Arnold do not overcome the deficiencies of Hassett as discussed above, the combined teachings of Marker, Jr. or Arnold with Hassett also fail to support the rejection as formulated by the examiner. Therefore, we do not sustain the rejection of claims 11 and 14.

In conclusion, we have not sustained either of the rejections set forth by the examiner. Accordingly, the decision of the examiner rejecting claims 9-14 is reversed.

REVERSED

ERROL A. KRASS
Administrative Patent Judge

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) BOARD OF PATENT

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